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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,171	06/27/2003	Daniel D. Auger	DEP754NP	7798

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EXAMINER

HOFFMAN, MARY C

ART UNIT	PAPER NUMBER
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3733

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/609,171	Applicant(s) AUGER ET AL.	
	Examiner Mary Hoffman	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
 4a) Of the above claim(s) 15-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14, drawn to a kit for locating a distal femoral resection plane, classified in class 606, subclass 87.
- II. Claims 15-23, drawn to combination cutting and spacer guide, classified in class 606, subclass 79.
- III. Claims 24-26, drawn to a method of resecting the distal end of a single condyle of a femur, classified in class 606, subclass 88.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the kit does not require an integral guide portion nor does it require an opening between the femoral surface and the tibial surface extending from at least one of the medial edge and the lateral edge. The subcombination has separate utility such as being used to resect the knee without the presence of a shim.

Inventions III and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used in a different location in the body, such as the ankle.

Inventions III and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used in a different location in the body, such as the ankle.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Stephen J. Manich on Feb. 24th, 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this

Office action. Claims 15-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Elliot et al. (U.S. Patent No. 5,720,752).

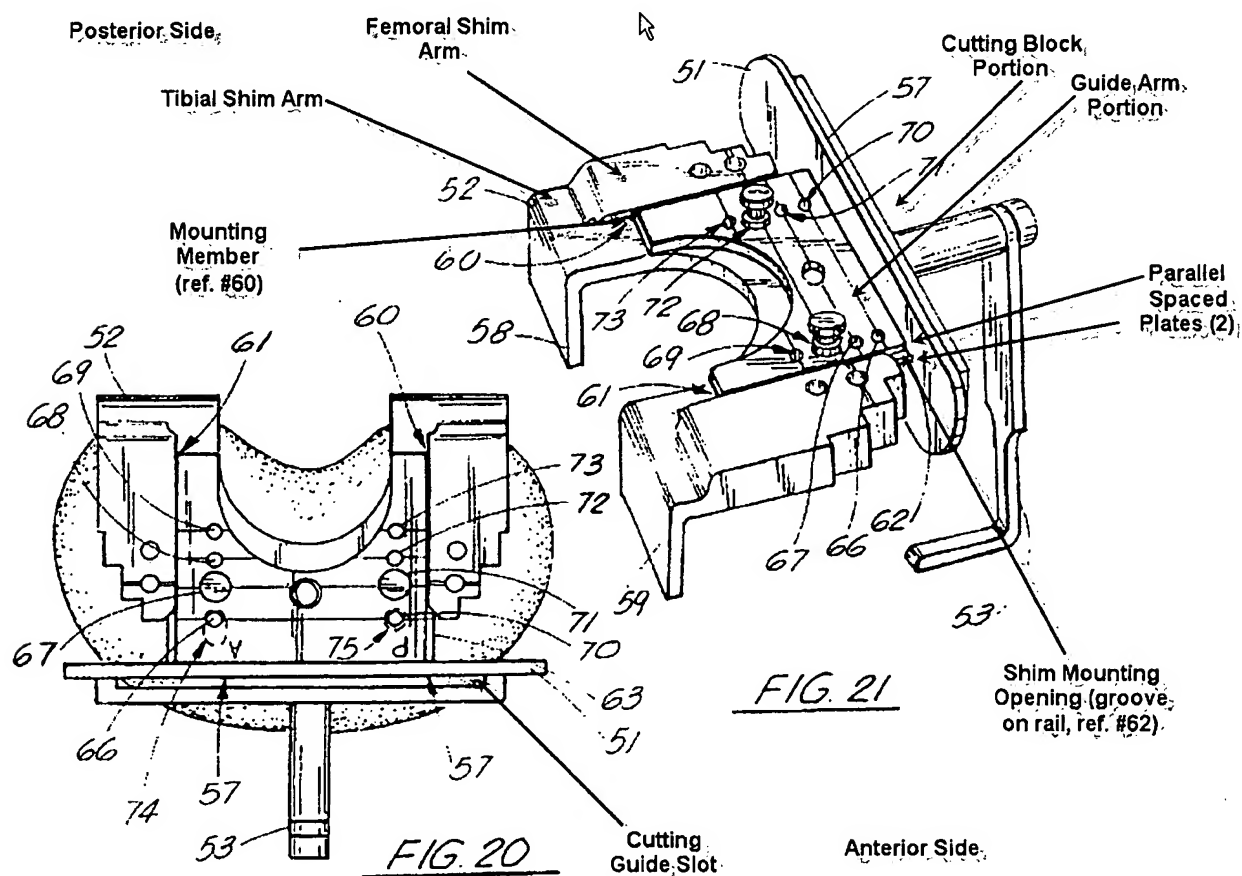
Elliot et al. disclose embodiments a kit for locating a distal femoral resection plane. Elliot et al. disclose a kit comprising a shim, including a shim arm and a mounting member connected to the shim arm, and a combination cutting and spacer guide, including a cutting block portion and a guide arm portion (refer to Figures 20 and 21 below). The cutting block portion has an anterior side and a posterior side and surfaces defining a cutting guide slot extending from the anterior side to the posterior side, the cutting guide slot lying in a plane defining the distal femoral resection plane. The guide arm portion has a posterior end spaced from the cutting block portion, a planar femoral surface extending outward from the posterior side of the cutting block portion to the posterior end, and a planar tibial surface extending from the cutting block

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portion outward to the posterior end, the tibial surface and femoral surface being substantially parallel to and spaced from the distal femoral resection plane. The combination cutting and spacer guide has a shim mounting opening, wherein the shim arm has a planar contact surface for contacting part of the guide arm and a planar contact surface for contacting part of one of the bones of the knee, the mounting member being sized and shaped to be receivable within the mounting opening of the combination cutting and spacer guide to removably mount the shim to the guide arm. The shim comprises a femoral shim and wherein the arm of the femoral shim has a surface area substantially the same as the surface area of the femoral surface of the guide arm of the combination cutting and spacer guide. The kit further comprises at least one tibial shim having a tibial shim arm and a tibial shim mounting member connected to the tibial shim arm wherein the tibial shim arm has a planar contact surface for contacting part of the guide arm and a planar contact surface for contacting part of the tibia, the tibial shim mounting member being sized and shaped to be receivable within the shim mounting opening of the combination cutting and spacer guide. The planar contact surface of the tibial shim arm has a larger surface area than the surface area of the femoral shim. The cutting block portion is removably mountable to the femur. The cutting block portion and the guide arm portion are integral. The cutting block portion has a bottom surface co-planar with the tibial surface of the guide arm (see FIG. 23). The guide arm and shim is capable of being received on a single side of the tibia. The shim mounting opening of the combination cutting and spacer guide comprises an elongate slot extending from the medial to the lateral side of the guide

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arm. The guide arm comprises a pair of spaced parallel plates integral with the cutting block portion (see rail portion, ref. #62, Fig. 21, two edges are being considered "parallel plates"). A further embodiment of the cutting block portion includes a plurality of holes (ref. #40, see Fig. 12) extending from the anterior side to the posterior side for mounting the combination cutting and spacer guide to the femur. The kit further comprises anchoring members receivable within the holes in the cutting block portion and a cutting member receivable within the cutting guide slot (col. 11, lines 17-25, and ref. #48, col. 11, lines 46-49).



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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliot et al. (U.S. Patent No. 5,720,752).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the kit for locating a distal femoral resection plane of Elliot et al. with a tibial surface of the guide arm having a maximum medial-lateral dimension of 32 mm and a maximum anterior-posterior dimension of 57 mm, the combination cutting and spacer guide having a maximum anterior-posterior dimension along the tibial surface of the distal side of the cutting block portion and the tibial surface of the guide arm of 67 mm, and the femoral surface of the guide arm having a maximum medial-lateral dimension of 17 mm and a maximum anterior-posterior dimension of 47mm., since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.

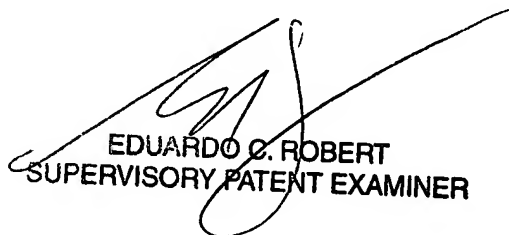
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCH



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER